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10/678,206	10/03/2003	Keith Colacioppo	9049	2120

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THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER	
DOAN, ROBYN KIEU	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/678,206
Filing Date: October 03, 2003
Appellant(s): COLACIOPPO ET AL.

Melissa G. Krasovec
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/5/09 appealing from the Office action mailed 12/10/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 00/69308 Hoffkes et al "Application device for highlighting hair" Nov. 23, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-19 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/69308.

With regard to claims 17 and 27, WO '308 discloses a hair treatment applicator (figs. 3 and 4) comprising a handle (the container to which the cap 1 screw into), a head (1) connected to the handle, the head comprising a first retaining structure (at 5, fig. 4) including a first base (at 14, fig. 8), a first plurality of tines (5) extending from the base, a first baffle (10, fig. 4) extending from the base which together form a first retaining volume, a second retaining structure (at 5) including a second base (14, fig. 8), a second plurality of tines (5) extending from the second base, a second baffle (10, fig. 4) extending from the second base which together form a second retaining volume; a passage (see figs. 3, 4 at 4) between first and second baffles, wherein the passage is free of hair treatment and a hair treatment (translated abstract) contained in the first and second hair retaining structures (Appellant is noted that when use, the container being turned upside down and if the user only dispenses a small amount of a hair treatment, then the hair treatment will be dispensed from the channel 3 to each of the retaining structures and to the scalp of the user, thus, the hair treatment cannot flow upward toward the passage area (4) due to the gravity, and therefore, it meets the claimed

language). In regard to claims 18, 19, first and second tines extend substantially perpendicularly to the first and second base (figs. 3, 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 20-26, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '308.

With regard to claims 20-26, WO '308 discloses the essential claimed invention except for the handle being integrally molded with the retaining structures, the applicator being molded as single piece an being made of polyethylene; WO' 308 also fails to show the shape of the tines being frusto-conical each tine with a proximal end diameter being .125 to .3125 inches and a distal end diameter of .0625 to .375 inches, a height of each tine being .25 inches to 1 inches and the passage width being at least .25 inches. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to form the handle and the applicator as a single piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the applicator being made of polyethylene, since it has been held to be within the

general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. And it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct each tine with a proximal end diameter being .125 to .3125 inches and a distal end diameter of .0625 to .375 inches, a height of each tine being .25 inches to 1 inches and the passage width being at least .25 inches, since such a modification would have involved a mere change in the size of the known component. A change in size is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). In regard to claims 28, 29, WO '308 fails to show the arrangement of the tines in the first and second rows as claimed in claims 28 and 29; however, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the tines in the particular arrangement as claimed in claims 28 and 29, since such modifications would involve in mere change in the arrangement design of the known component.

(10) Response to Argument

Appellant has argued on page 4, lines 14, 15 of the brief that the passage (4) cannot be substantially free of hair treatment, as hair treatment is dispensed into the passages as shown in figure 4 of Hoffkes et al.

Appellant is noted that limitation "said passage is substantially free of said hair treatment" is an intended use limitation, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, as discussed above, when using the device, the container being turned upside down and if the user only dispenses a small amount of a hair treatment, then the hair treatment will be dispensed from the channel 3 to each of the retaining structures and to the scalp of the user, thus, the passage is free of hair treatment because the hair treatment cannot flow upward toward the passage area (4) due to the gravity, and since the device is capable of performing the intended use, it meets the claimed language.

Appellant has further argued on page 7, lines 14 and 15 of the brief that if the passage were free of hair colorant during use, this would indicate that the outlets (channels 3) of the applicator device were clogged. This is not correct because the passage (4) of Hoffkes et al will be free of hair treatment depending on the amount of hair treatment being dispensed, if the user only dispenses a small amount of hair treatment at a time while holding the device upside down, then the passage (4) is free of hair treatment.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R.D./

Conferees:

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732

/Thomas C. Barrett/
Supervisory Patent Examiner, Art Unit 3775